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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/552,969	04/20/2000	Scott Dax	ORT-1230	6221

7590 01/14/2004
Audley A Ciamporcero Jr
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003

EXAMINER

LIU, HONG

ART UNIT PAPER NUMBER

1624

DATE MAILED: 01/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/552,969

Applicant(s)

DAX ET AL.

Examiner

Hong Liu

Art Unit

1624

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attached Advisory Action.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-14, 20 and 22.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

ADVISORY ACTION

The after final amendment filed on 11/24/03 is acknowledged. Applicant's arguments have been fully considered but they are not persuasive. Applicants argue that in claim 1 in both applications, B1 is defined as hydrogen, B2 is hydrogen, alkyl, R2 is hydrogen, alkyl, Y is methylene or carbonyl, etc. While it is true that the definitions of these variables are similar, the variables actually belong to compounds of different structure. There should be no dispute that Formula A in the Provisional Application is different from Formula A of the non-Provisional Application. The Y-L-Z group of formula A is attached at different position of the benz[e]indole ring in the two applications. Therefore, even though the definitions of B1, B2, R2, and Y are similar, the definitions apply to structurally different compounds and the similarity of the definitions are of no consequence. Likewise, the language on page 37, lines 29-33, which describes the preparation of those compounds wherein B2 and R2 are other than hydrogen also refers to compounds of formula A of the Provisional Application, not compounds of formula A of the present application. The only support for compounds of formula A of the present application is the compounds of formulas IX, X, XIII and XIV on pages 29 and 30 of the Provisional Application, which have a much narrower scope than formula A of the present invention. No utility is given to compounds of formulas X, XIII, and XIV. In fact, applicants directed the Examiner's attention to these formulas rather than formula A in their first response to the issue. They are only described in the synthesis scheme and no generic description of the instant compounds of formula A can be found in the specification of the Provisional Application. For these reasons, claims 1-14 are still not deemed to be entitled to the priority date and the rejection under 102(a) is maintained.

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Applicants amended claim 19 such that it now depends on claim 1 rather than claim 15 which was withdrawn from consideration in the previous Office Action. Changing the pendency of claim 19 from depending on a withdrawn claim to a currently pending claim constitutes a new issue. In order to reject this claim, the Final action has to be withdrawn and the claim has to be examined in light of prior art, which would require more than a cursory review of the application.

Applicants are reminded that entry of amendment after final rejection is not a matter of right. "Except where an amendment merely cancels claims, adopts examiner suggestions, remove issues for appeal, or is some other way only a cursory review by the examiner, compliance with the requirement of a showing under 37 CFR 1.116(b) is expected in all amendments after final reelection." See MPEP 714.13. For these reasons, this amendment after final rejection will not be entered.

Any inquiry concerning this communication should be directed to Examiner Hong Liu whose telephone number is (703) 306-5814. The examiner can normally be reached on Monday through Friday from 8:30 AM to 6:00 PM. If attempts to reach the examiner by the phone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached at (703) 308-4716. The fax phone number for this group is (703) 308-4734 for "unofficial" purposes and the actual number for **official** business is (703) 308-4556. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose number is (703) 308-1235.

hl
January 8, 2004



Mukund Shah
Supervisory Patent Examiner
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